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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,837	03/26/2001	G. Eric Engstrom	41003.P019	9404

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EXAMINER

SMITH, TRACI L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,837

Applicant(s)

ENGSTROM, G. ERIC

Examiner

Traci L Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

DETAILED ACTION

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Refs. 608, 610, 817 and 818. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 4-5, 13, 20-21, 30-32, 34-35 and 40 are rejected under 35 U.S.C 112, first paragraph, as failing to comply with the enablement requirement. The claim(s)

contain subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Dynamically generated is not defined in the specification as to what or how the process is accomplished.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-8, 10-14, 26-34 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. As to claims 7 and 8 they recite the limitations "the client" and "said client" in line 2 of claim 7 and line 2 of claim 8. There is insufficient antecedent basis for these limitations in the claims.

8. As to claims 10-14, they claim a system **and** a method which renders the claims indefinite, as the examiner is unable to determine what process/method is encompassed in the scope of the claims.

9. As to claims 27-34 they recite an "**execution unit**" *coupled to the storage medium*. The term "execution unit" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree of understanding.

10. As to claims 26 and 44 as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. The omitted steps are: inputting personality characteristics into a database. The claims site a step for "retrieving" said

characteristics from a database. In order to retrieve information out of a database it requires first a said means for inputting the information into that same database.

Claim Rejections - 35 USC §101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

12. Claim 1-27 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

13. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

14. In the present case, claims 1-27 and 32 do not include a computer system for means to manipulate the data collected and exchanged, which does not fall within the scope of the technological arts.

15. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-17, 19-22, 25-37, 39-40 and 43-44 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,119,101 Peckover.

18. As to claims 1, 10, 15, 22, 27 and 35 a method and apparatus for requesting information, supplying personal information to gain access to said requested information, ***Peckover teaches a computer network agent system for providing communications anonymous potential consumer of products...and a provider of such products...receiving anonymous product queries from consumer...provider personal agent for receiving demand queries from provider and transmitting quantified demand information to the provider(C.39 I.17-32).***

19. As to claims 2, 11, 20 and 30 **consumers and providers are each represented in the system by Personal Agents. A personal agent learns the preferences of it's human owner(C.14 I. 36-37)**

20. As to Claims 3, 12, and 31 **a method where consumer personal agent is capable of creating a decision agent to carry out a search...for products that satisfy certain constraints and preferences.**

21. As to claims, 4, 13 ,32 and 40 **a consumer may have multiple decision agents active within the system a unique ID is generated automatically when the agent is created.(C. 21 I.28-30 and 37-38)**

22. As to claims 5,14, 21, 29 and 33 **Provider Personal Agent is capable of creating a demand agent...from a market about consumer data.(C. 15 I. 42-44))**

23. As to claim 6, **demand agent returns a response for the query to the Provider Personal Agent. (C. 15 I.49-50)**

24. As to claims 7 and 8, **providers preferences determine how to present the retrieved data to the provider.(C.15 I. 51-52)**

25. As to claims 9, 16, 28 and 36 **communication devices can be any device capable of communicating over the internet...other devices capable of operating with computer control.(C. 16 I. 29-33)**

26. As to claims 17 and 37 **other means of transferring data and commands between the user and the agent system.(C.16 I.33-34)**

27. As to claims 19, 25, 39 and 43 ***preference manager function maintains data about the preferences of the user...such as favorite brands, interest in sports etc.(C.19 I. 3-5)***

28. As to claims 26 and 44 ***personal agent search engine maintains indexes over preference data and demographic data of all personal agents so that users may query to identify a set of personal agents whose users have certain characteristics or preferences.(C. 16 I. 49-52)***

29. As to claim 34 ***log function for storing records of the activities of demand agents for later consultation by other components of agent system(C. 41 I. 47-49)***

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 23-24, 38 and 41-42 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,119,101 Peckover as applied to claim 17 above, and further in view of talkcity.com. As to claims 18, 23, 38 and 41 ***talkcity teaches an online chat system that allows the service provider(talkcity) to host multiple chat sessions for talkcity members.(talkcity.com pg.1)***. As to claims 24 and 42, ***talkcity teaches a method of allowing third party providers to host their own chat sessions.(Pg. 4 I.11-14)***

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. European patent EP 1,209,849, A2, Colson et al. A method, system and apparatus for persistent chat sessions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls



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